Supreme Court of the United States

OCTOBER TERM, 1941

No. .

AMERICAN TRI-ERGON CORPORATION and TRI-ERGON HOLDING A. G.,
Petitioners (Plaintiffs),

v.

RADTKE PATENTS CORPORATION and ALBERT A. RADTKE, WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON, CONWAY P. COE, COMMISSIONER OF PATENTS,
Respondents (Defendants).

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I

Opinions below.

The opinion of the District Court is reported at 30 Fed. Supp. 83. At this writing the opinion of the Circuit Court of Appeals has not been officially reported.

II

Grounds of jurisdiction and statement of case.

The above matters are believed to be sufficiently set forth in the foregoing Petition.

III

Assignment of errors.

Petitioners urge that the United States Court of Appeals for the District of Columbia erred:

1. In reversing the decree of the District Court and directing dismissal of petitioners' complaint.

2. In finding lack of invention in the technical subject here involved, on the basis of the Court's own appraisal of scientific treatises, many of which were not in evidence and some later in date than petitioners, and without testimony of those skilled in the art or findings of the trial court or of the Patent Office, supporting the Court's view that these treatises rendered the whole matter obvious.

3. In holding the subject matter to be unpatentable in the face of the findings of two District Judges and the *final* rulings of the Commissioner of Patents to the contrary.

4. In adopting an *initial* ruling of the Commissioner of Patents as a basis of applying the rule that "if there was a rational basis for that decision it should be sustained," under circumstances where all the later and *final* rulings of the Commissioner were to the contrary.

5. In holding the subject matter to be unpatentable on the basis of matters outside of the pleadings and proofs, and as to which petitioners have had no fair opportunity to be heard.

6. In according evidential weight on the question of patentability, to "contentions" or "positions" taken in argument by counsel opposing petitioners.

7. In finding any "repudiation" by petitioners of any of the findings of the District Court.

8. In finding features of the claimed combinations to be unpatentable because petitioners' original application did not proclaim them to be of inventive character.

9. In treating statements made by petitioners in respect to amplifiers and their circuits, as admissions of lack of invention in petitioners' immediate photoelectric cell circuit.

10. In holding experimenting and writings by others which never achieved any success to be evidence of lack of invention.

IV

Argument.

POINT 1

Petitioners were not previously confronted with the contentions advanced in the majority appellate opinion as to lack of invention, and had no fair hearing thereon.

As ground for dismissing petitioners' complaint, the majority appellate opinion boils down to a hypothetical finding that one skilled in the art, with knowledge of the scientific treatises cited and exercising only ordinary skill of the calling, would have conceived that successful sound reproduction could be achieved by the claimed combination of elements, and would have been able to assemble the combina-

tion and make it work successfully. No finding short of this would have been of legal significance since as held in *Seymour* v. *Osborne,* 11 Wall 516, 555:

> "Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation."

The pleadings supported no such defense. The Commissioner's Answer on the contrary asserted the correctness of the interference decision of his Board of Appeals, to the effect that even with a knowledge of petitioners' application disclosure "considerable additional experimentation and invention" would be needed to make this disclosure operative (*supra,* p. 4). Radtke and Whitson each pled that he was the *inventor* thereof (*supra,* p. 4).

We have likewise searched the record in vain for testimony of any witness to the effect that these scientific treatises either singly or collectively would enable one skilled in the art to conceive and put into practice the claimed combinations. Neither the Commissioner nor the other defendants undertook at the trial to establish by testimony what the Appellate Court has now found. If some witness had undertaken to assert the proposition and explain wherein the things which the publications did disclose would be sufficient to make the subject matter obvious to one skilled in the art, and wherein the things not disclosed would have been no obstacles, then petitioners might have been put on notice to cross examine and present rebuttal evidence on the points raised, but nothing of that sort occurred at the trial.

Consequently there was no occasion or opportunity for petitioners to cross examine on these matters which the majority opinion itself refers to as "intricate and technical questions" (III R. 2059), nor occasion nor opportunity for petitioners to present rebuttal evidence thereon.

On the argument in the Court of Appeals, motion was made that a brief submitted amicus curiae against patentability be received. It was then stated in open court from the Bench that if the brief should be considered, opportunity would be accorded the litigants to answer it, but the decision was rendered without such opportunity.

At III R. 2060 the majority opinion quotes statements from an initial Patent Office decision back in 1927 about certain Fritts and British patents, over which Justice Adkins held petitioners entitled to a patent (II R. 1640). These patents were neither pled nor included in the present record, nor any evidence presented in regard to them. We submit that it was not incumbent upon petitioners as part of their *prima facie* case to resurrect previously discarded patents or publications on which neither the Commissioner nor any of the other defendants saw fit to introduce evidence in the present suit, and which were not the grounds of any *final* action by the Patent Office.

Although the majority opinion says that the above initial Patent Office rule states the "reasons which, in our opinion, support the conclusion that there was no invention" (III R. 2060) the reasons the Court goes on to give for its holding (III R. 2061-78) are in nowise founded on the above Fritts and British patents, but upon other scientific treatises on which the above initial Patent Office decision made no findings (II R. 1619).

In short, neither by the pleadings nor the proofs, were petitioners apprised of any issue as to matters of technical fact and opinion such as the majority opinion saw fit to raise and determine, nor was evidence presented thereon.

> "In such a case, the question is whether the difference or differences between the subject claimed in the pat-

> ent in suit and the prior art, amount to invention; and it is generally necessary for a defendant to introduce expert testimony on that point (Waterman v. Shipman, 55 Fed. 982, 987, C. C. A. 2 [1893], for a question of invention is a question of fact)" (citing authorities) (*Walker on Patents,* Deller's Ed. Vol. 3, p. 2025).

The subject matter here involved plainly is not so simple as to justify departure from the general rule.

> "The flow or flux of electric or magnetic currents, the reactions of bodies into some chemical union or disunion, are matters in which a court must perforce depend upon the assertions of some one who has made a profound study of the matter" (*Sundh Elec. Co.* v. *General Elec. Co.* [2 Cir.], 204 Fed. Rep. 277, 279).

We submit that the dissenting appellate opinion speaks eloquently on the above points in stating that the majority's finding is at least debatable and ought not in fairness to be decided for the first time on appeal; that an appellate court should not take judicial notice of disputable facts or

> "reach an answer to such a question upon the basis of its own examination of data not in the record, * * * without first affording opportunity to the parties to be heard in respect of it and an opportunity to supply additional relevant data" (III R. 2080).

As in *Helis* v. *Ward,* 308 U. S. 365, certiorari is here sought on the ground that the Court of Appeals has

> "decided the merits on facts not contained in the record and on a theory which had never been tried by the litigants" (308 U. S. 370).

POINT 2

The appellate finding of lack of invention is predicated upon a legal principle which points directly to the opposite conclusion.

We have referred *supra,* page 6 to the fact that the majority opinion adopts the *initial* ruling of unpatentability by the Commissioner as a basis for applying the principle that the "judicial function is exhausted when there is found to be a rational basis for the conclusions approved by the administrative body" (III R. 2059), citing *Mississippi Valley Barge Line Co.* v. *United States,* 292 U. S. 282, 286, 287. A similar rule was announced in *Morgan* v. *Daniels,* 153 U. S. 120, 125 as to final rulings of the Patent Office.

But in the present case all of the *later* and *final* actions and rulings of the Commissioner referred to *supra,* pages 3, 4, were to the effect that the subject matter involves invention and is patentable. According to Rule 93 of the Patent Office Rules of Practice, interference proceedings are declared

> "between two or more parties claiming substantially the same patentable invention, and may be instituted as soon as it is determined that common patentable subject matter is claimed."

Thus the declaration of the interference (*supra,* p. 3, item [3]) necessarily involved a finding of patentable subject matter and invention. Likewise the Patent Office award of priority of *invention* (III R. 1998) was also a ruling of patentability. The Patent Office interference rulings that even with a knowledge of petitioners' application disclosure, additional "inventive features" would have to be used in practicing the invention (*supra,* p. 4, item [4]) were in the extremist sense reversals of the initial ruling adopted by the majority of the Appellate Court. As noted *supra,* page 4, the Commissioner's Answer in the present suit denied

that the interference rulings were incorrect, but did not assert the subject matter to be lacking in invention. The action of the Commissioner in issuing Radtke's patent (*supra,* p. 4, item [5]) was also a later ruling of patentability of the most final character.

Thus the very legal principle upon which the majority Appellate opinion is founded, points to a finding directly opposite to the one made.

POINT 3

The majority appellate finding of lack of invention is without justifiable basis.

We have referred *supra,* pages 17, 18 to the legal principle that supporting testimony of those skilled in the art is required as a foundation for such a finding on "intricate and technical questions" (majority opinion III R. 2059) as here involved, and to the absence of such testimony in the present evidence.

The *final* rulings of patentability by the Commissioner, as already discussed, are another reason why the action of the Appellate Court was unjustified. And in so far as the scientific documents cited by the Appellate Court were in the record and before either of the District Judges, their concurrent finding of patentability are supported by the rule that "so far as there is any testimony consistent with the finding, it must be treated as unassailable" (*Adamson* v. *Gilliland,* 242 U. S. 350, 353). Perusal of Justice Adkins' findings (II R. 1633-46) will show many of them with which the majority Appellate decision in nowise undertakes to disagree, and which are consistent with the finding of invention.

At III R. 2063 the majority opinion undertakes to criticise a part only of Justice Adkins' Finding No. 7 (II R. 1636) but, as we submit, without showing any error therein. Justice Adkins' Finding No. 10 is criticised at III R. 2064 and

Finding No. 15 at III R. 2072, on the ground that petitioners originally advanced no such "claims". We are aware of neither reason nor authority depriving a man of the benefit of proven facts on any such ground. No applicant is required to include in his application allegations to the effect that he was "the first to investigate and demonstrate that photoelectric cells possessed such characteristics as to meet each of "the peculiar requirements of sound reproduction" (III R. 2064), nor allegations to the effect that he was "the first to devise suitable connections between the photoelectric cell, etc." (III R. 2072), in order to preserve his rights to such features of novelty therein as may appear by the actual facts. When petitioners first had opportunity to present evidence they proved the above facts as Justice Adkins found, and nothing cited by the Court of Appeals amounts to evidence demonstrating that Justice Adkins was incorrect. The allegation that petitioners had not previously "claimed" to have done this or that, is consistently adopted in the majority opinion as a basis for finding "repudiation" by petitioners of findings they proved to be facts (see III R. 2066, 2071, 2073).

Scattered throughout the majority opinion are references to what Radtke or Whitson "contends" (*e. g.*, III R. 2065, 2067, 2071, 2072) which are cited in support of the Court's finding. These references in every instance are to assertions or contentions by counsel, which we submit to be in nowise binding on petitioners or of the slightest evidential weight against them. Such assertions (in each instance matters of technical fact or opinion) are not subject to cross examination nor to rebuttal evidence on the asserted propositions of fact or opinion, and there was no corresponding testimony. Of what significance is it as against petitioners, for example, that Radtke's counsel asserted Justice Adkins' was "misled" into making his Finding No. 15 (III R. 2072); the finding could be outweighed only by sufficient legal evidence to the contrary, and there was none.

And at III R. 2070-2072, the majority opinion misconstrues statements made in petitioners' application to the effect that appropriate amplifiers were known, as admissions of lack of novelty or invention in the circuit leading from the photoelectric cell to the amplifier. On this basis the parts of petitioners' claims having to do with the immediate photoelectric cell circuit in which flows a "correspondingly modulated current" were cast aside by the Court. The "acoustically modulated light" part of petitioners claims was also ignored in the face of Justice Adkins' undisputed finding (II R. 1638, fol. 2359) that even this part of the combination did not exist in any accurate and sufficient sense prior to petitioners.

By thus unjustifiedly eliminating the above parts of petitioners' claimed combination from consideration, the Court reduces its discussion to the question (as an isolated abstraction) of whether it required invention to deduce that a photoelectric cell might be usable for sound reproduction, and even as to this the Court ignores Justice Adkins' Finding No. 11 (II R. 1638) to the effect that there were no preexisting instruments by which its qualities for that purpose could be tested. The facts found by Justice Adkins (see No. 8, II R. 1637) as to the highly complex vibrations of widely different intensities and frequencies of which sound waves are composed, and the need of reproducing these accurately and faithfully before sound reproduction in any useful sense exists, the lack of any prior practical use whatsoever of the photoelectric cell (II R. 1636 No. 7), the fact that the photoelectric cell could not be used in circuits which had previously been proposed for the unsuccessful selenium cell (II R. 1639 No. 14), petitioners' pioneership throughout the world in successful sound-on-film reproduction (II R. 1635 No. 4), the radical differences in requirements and operating conditions between sound reproduction and other proposed uses of photoelectric cells (II R. 1642-1645 Nos. 21 to 31), are all ignored.

A large part of the majority opinion merely goes to show that there were such things as photoelectric cells prior to petitioners (III R. 2063-66) and that it was known how to make them, a fact which Justice Adkins himself noted (II R. 1636 No. 7). At II R. 2065 a statement on behalf of petitioners that people knew how to make photoelectric cells is emphasized in the majority opinion, and is followed by an entirely unwarranted deduction that others skilled in the art would "presumably" know all that petitioners' inventors knew.

In short, bearing in mind the above unwarranted and speculative inferences and deductions, and the utter lack of *evidence in the case* substantiating them, we submit the lack of legal foundation for the majority finding of unpatentability becomes plain.

POINT 4

Unsuccessful prior efforts by others are evidence of invention rather than the lack of it.

At III R. 2077 the majority states the fact that "numerous others for many years have been experimenting and writing toward that same objective, is suggestive in itself that what is here involved is not invention". But the fact findings of Justice Adkins showed that all prior attempts to accomplish that objective had been unsuccessful (II R. 1636 No. 6) and that petitioners were the first to succeed (II R. 1635 No. 4). There was no evidence here, as in the prior Tri-Ergon cases cited at III R. 2077, that the present combination relates to auxiliary or collateral matters not going to the heart of the problem, nor any explanation why others failed to take the steps which led petitioners to success. Under such circumstances the history of the art is evidence supporting invention and not in derogation thereof. (*Smith* v. *Snow*, 294 U. S. 1, 6; *The Barbed Wire Patent Case*, 143 U. S. 275, 283; *Eibel Process Co.* v. *Minnesota & Ontario Power Co.*, 261 U. S. 45.)

POINT 5

The subject matter is of general importance justifying review by this Court.

In the prior Altoona case (*supra*, p. 3) certiorari was granted by this Court in the absence of any divergence of judicial opinion upon the questions involved. As shown *supra*, page 3 the present subject matter is of equal importance, and accordingly is respectfully submitted to be equally entitled to review, under this Court's Rule 38, 5 (c).

POINT 6

The decision of the Court of Appeals if permitted to become final will unjustly relieve Radtke's already issued patent from the consequences of petitioners' adjudicated priority over Radtke, so that this defense against the Radtke patent could not later be presented to this Court or any other court in any other case.

The effect of the Court of Appeals' decision of course is to deny petitioners a patent upon their application, under circumstances where Radtke's conflicting patent has already been issued by the Commissioner (III R. 1798), and despite concurrence by the Court of Appeals in the District Court's finding that petitioners have established priority of invention over Radtke (III R. 2077).

Under the doctrine of *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5, 13, 14, petitioners' priority thus found will not be available to anyone as a defense against the Radtke patent, unless a patent issues to petitioners.

If the Court of Appeals decision stands, Radtke will thus be left free to litigate his patent in other jurisdictions, and with petitioners' priority eliminated as a defense by the force of the same decision which holds that in view of petitioners' priority "Radtke invented nothing" (III R. 2077).

This we submit to be an unjust and anomalous situation, which can come before this Court in no later litigation. (See *Schriber-Schroth Company* v. *The Cleveland Trust Company,* 305 U. S. 47, 50, as supporting review by this Court under analogous circumstances.)

POINT 7

The Court of Appeals acted as the Guardian of the Radtke interests rather than those of the public.

As a basis for its excursion outside of the record on an investigation of patentability, the majority appellate opinion refers "to our capacity as the guardian of the public interest" (III R. 2059) as if the Court were thereby shielding the public from a patent monopoly. This is not the case in view of Radtke's already issued patent which is still left outstanding with the support of the final rulings of the Commissioner of Patents and two District Judges to the effect that the subject matter is patentable, with two appellate judges holding to the contrary and the third appellate judge holding that the ruling of the other two was unjustified.

As above pointed out, the action of the Court merely "guards" Radtke's interests, and those of his licensees (*supra,* p. 9), by eliminating as a defense to the Radtke patent, petitioners' priority which the District Court and the Court of Appeals concurred in holding to be established. We fail to see where the public interest is aided by the creation of such a situation, and similar conclusions have been reached by other Circuit Courts of Appeals (*Larson* v. *Crowther* [8 Cir.], 26 Fed. 2nd 780, 790; *Cutler Hammer Mfg. Co.* v. *General Electric Co.* [7 Cir.], 6 Fed. 2nd 376, referring at page 378 to too great sympathy for the rights of the "public" under similar circumstances).

POINT 8

The Court of Appeals has misapplied this Court's decision in Hill v. Wooster, 132 U. S. 693.

As the dissenting appellate opinion points out "a very different situation exists" (III R. 2079) in the present case, both because the Commissioner of Patents as a representative of the public has been at all times a party defendant herein and neither pled nor presented evidence on the points raised in the majority appellate finding; and for the further reason that in a previous suit against the Commissioner as the representative of the public interest, the patentability of the subject matter was adjudicated ten years ago, the decision was not appealed by the Commissioner and became final, and has not since been questioned by any of the tribunals until the majority appellate opinion saw fit to do so on the basis of the Court's own independent researches. Also, it appears that the decision in *Hill* v. *Wooster* was rendered on facts in the record, and upon simple subject matter which the Court could fairly pass upon without the aid of testimony of those skilled in the art on the points involved, and in contrast with the "intricate and technical" (III R. 2059) subject matter here involved, as to which we submit that it was not competent of members of the Court to undertake to serve as their own experts.

For all of the above reasons it is respectfully urged that the writ should be granted.

KENNETH S. NEAL,
PAGE S. HASELTON,
Counsel for Petitioners.

Dated, New York, September 25, 1941.

FILED
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CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM 1941

No. 661

AMERICAN TRI-ERGON CORPORATION and TRI-ERGON HOLDING A. G.,

Petitioners (Plaintiffs),

v.

RADTKE PATENTS CORPORATION and ALBERT A. RADTKE, WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON, CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondents (Defendants).

MEMORANDUM FOR PETITIONERS IN REPLY TO BRIEF OF RESPONDENT—COMMISSIONER OF PATENTS

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Dated: October 31, 1941.

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Respondents (Defendants).

MEMORANDUM FOR PETITIONERS IN REPLY TO BRIEF OF RESPONDENT—COMMISSIONER OF PATENTS

1. The Commissioner's Statement of the "Questions Presented" is Inadequate.

We do not agree with the Commissioner's statement of the "Questions Presented" (his brief, pages 2, 6). The petition presents not the abstract question of whether an Appellate Court "may consider" the matter of invention in an action of this character, but the question of whether it is consistent with the requirements of a fair hearing, or consistent with accepted Federal Procedure, for an Appellate Court in so doing to formulate its own findings of lack of

invention on *de novo* grounds involving scientific treatises, many of which are not in evidence, and none of which are accompanied by the testimony of witnesses skilled in the art supporting the Court's conclusions, nor by findings of the District Court or the Patent Office in respect thereto, and as to which matters petitioners were never apprised by the pleadings or proofs, and therefore had no opportunity for cross examination or rebutting evidence.

We further differ decidedly with the assertion in the Commissioner's brief (p. 10) to the effect that an Appellate Court in a suit under usual Federal procedure and involving subject matter which the Court itself termed "intricate and technical" (III R. 2059) may "draw the inference of no invention * * * in the absence of supporting testimony of any expert witness". The brief correctly states that such an "inference may be drawn by the Patent Office" in conducting its administrative practice of ruling upon such matters without hearing any witnesses at all, upon the presumption that the various Examiners are skilled in their respective "arts". But an entirely different situation exists in the present suit, wherein decision is to be rendered according to the usual rules of Federal Procedure. On the basis of its own ruminations and without the support of witnesses skilled in the art, or findings on these treatises by either the District Court or the Patent Office, the Appellate Court has found *de novo* that one skilled in the art with knowledge of such treatises could have evolved the claimed combinations without the exercise of inventive talent. On such an issue—

> "the question of whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is one of fact" (*Thompson Spot Welding Co.* v. *Ford Motor Company,* 265 U. S. 445, 446).
>
> "So that it certainly was not a matter of mere judicial knowledge that these differences were either not material in any degree to the result or, if material at all, were only such as would not require the exercise of the faculty of invention but would be suggested by the

skill of an experienced workman" (*Keyes* v. *Grant,* 118 U. S. 25, 36, 37).

The "course of equity * * * under the Federal system presupposes the finding of material facts by the trial Judge" (*Lorenz* v. *Colgate-Palmolive-Peet Co.* [3 Cir.] decided October 1, 1941, 51 U. S. Patents Quarterly 72, 77).

Accordingly we respectfully submit that the majority Appellate opinion below went beyond its proper province in going outside the Record to rule on *de novo* grounds affecting such factual questions which the Court itself characterized as "intricate and technical" (III R. 2059).

2. The Rule of Decision Emphasized in the Commissioner's Brief Applies Only to the Final Patent Office Rulings of Patentability, and not to Earlier Conflicting Rulings.

At page 11, the Commissioner's brief urges that the Court was "bound" to find "there was no invention as determined by the Patent Office in 1927." Although the Commissioner's brief (p. 9) concedes that the later Patent Office interference rulings would "ordinarily" be determinations "of patentability" superseding the 1927 rejection it is suggested that the present case should be treated on a different footing, on the ground that the Commissioner "considered himself bound by the 1931 decision" (Com'rs. brief, pp. 8, 9; the "1931 decision" being the District Court's decree by Justice Adkins that petitioners are entitled to a patent on their application).

But the Commissioner's rulings (through his Interference Tribunals) following Justice Adkins' decree show very plainly

(1) That the Patent Office did not consider itself bound thereby in the interference proceedings; and

(2) A reversal in the extremist sense of the initial Patent Office ruling against patentability.

In the interference the Patent Office held that even with a knowledge of petitioners' application disclosure additional "inventive features" would have to be used to enable one skilled in the art to practice the invention (III R. 1998, also I R. 30). This was the ground on which the Patent Office held petitioners' application disclosure insufficient, denied a patent to petitioners and issued a patent to Radtke instead (III R. 1798). This ruling was a far cry from being bound by Justice Adkins' decision, since as the District Court pointed out in the present suit (II R. 1517) Justice Adkins in rendering his decision necessarily found petitioners' disclosure application sufficient. Furthermore the above Patent Office interference decision in finding "inventive features" supplementary to petitioners' application disclosure would be necessary to practice the invention, is diametrically opposed to the initial Patent Office decision to the effect that the prior art renders the whole matter obvious and non-inventive. In so ruling the Patent Office went Justice Adkins one better on the subject of patentability.

This Patent Office interference decision—utterly inconsistent with a finding of lack of invention,—was the final ruling of the Patent Office with which petitioners and the Courts were confronted in the present suit, and we submit, the only ruling to which any legal presumption of correctness could be properly attached. How could such a presumption reasonably also embrace an earlier inconsistent ruling from which the Department itself had departed, and thus render both of two inconsistent departmental rulings presumptively correct?

In the present suit the Commissioner pled that the decision of his "Board of Appeals in said interference" was correct (I R. 19) and we submit that no presumption of correctness can be legitimately applied to earlier Patent Office rulings inconsistent therewith. The matter cannot be disposed of as the Commissioner's brief undertakes to do at page 11 by urging (contrary to the Patent Office in-

terference rulings and pleadings herein as above mentioned) that there is "ample support in the record" for the Appellate finding of lack of invention. If the majority of the Appellate Court had been satisfied to rest on evidence in the record, why would the large number of extraneous publications have been marshalled in support of their findings, particularly when their action in so doing was one of the grounds of the dissenting Appellate opinion (III R. 2079-80). *The majority findings were predicated on the sum total of these publications irrespective of whether within or without the Record, or earlier or later in date than petitioners.* There was no Appellate finding that any of them *disclosed* the claimed combinations, nor that the publications in the record are sufficient to show lack of invention, nor did the Patent Office or the District Court so find, and we submit that the above assertion now made in the Commissioner's brief is not a sufficient substitute for appropriate and timely pleadings and proofs affording opportunity for rebutting proofs by petitioners.

Accordingly we submit that the Commissioner's brief fails to advance sound reasons sustaining the action of the Appellate Court in going outside of the record to formulate *de novo* grounds for *de novo* findings of fact, and without according to petitioners a fair hearing on the disputable issues of technical fact thereby raised and determined by the Appellate Court on the basis of its own appraisal of these technical matters.

Respectfully submitted,

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Dated: New York, N. Y., October 31, 1941.